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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,981	03/14/2002	Florence L'Alloret	220760USOPCT	2976

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EXAMINER
EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
11/02/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/069,981	L'ALLORET, FLORENCE	
	Examiner	Art Unit	
	Dr. Kelechi C. Egwim	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-69* is/are pending in the application.

4a) Of the above claim(s) *27,31,34,35,37,38,46-48,50-53,56-60 and 62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25,26,28-30,32,33,36,39-45,49,54,55,61 and 63-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for reason cited in the previous action.

Further, there is also insufficient support in the originally filed description for an embodiment where the polymer has absolutely "no cloud point", as recited in the present claims.

Claim Rejections - 35 USC § 102

3. Claims 25, 26, 28, 30, 32, 33, 40-45, 49, 55 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant Jr. et al., for reasons stated in previous Office Actions.

4. Claims 25, 26, 28, 29, 33, 40-45, 49, 55 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Koerner et al., for reasons stated in previous Office Actions.

5. Claims 25, 26, 28, 29, 32, 33, 39-45, 49, 55 and 63-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogel et al., for reasons stated in previous Office Actions.

Claim Rejections - 35 USC § 103

6. Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Maroy et al., for reasons stated in previous Office Actions.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of 44-46, 104, 110, 116, 119, 125, 126,

131, 134-136 and 143-144 copending Application No. 10/069,983, for reason stated in the previous action.

Response to Arguments

9. Applicant's arguments filed 08/20/2007 have been fully considered but they are not persuasive.

10. Firstly, regarding the 112 1st ¶ rejection, applicant's specification on page 9 only refers to water-soluble "units" have solubility in a range of 5 to 80°C. There is no mention of the entire copolymer, as a whole, being soluble at all temperatures from 5 to 80°C. Thus, the new matter rejection is maintained.

11. Regarding Merchant, appellant continues to argue as if, because it may be preferred, the maleic anhydride/alkyl phenol formaldehyde resin is the only copolymer of the LCST containing water-soluble polymer taught in Merchant. As previously stated, Merchant also teaches oxyalkylated amines, glycol resin esters, oxyalkylated polyols and oxyalkylated alkyl-phenol formaldehyde resins (the oxyalkylating groups are consistent with the defined LCST units and the amines, polyols and alky-phenol formaldehyde resins are consistent with the defined water-soluble units). (See pages 13-16 of the preset specification for applicant's own definition and examples of LCST units)

As previously stated, it is well settled that anticipatory teachings are not limited to any particular embodiment/example. In re Boe, 148 USPQ 507 (CCPA 1966). Disclosed examples and preferred embodiments (even if the embodiments tested by appellant were preferred) do not constitute a teaching away from a broader disclosure. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Thus, the argument with regard to "the Malcolm Publication" is still not persuasive, as they are limited to only one of the many embodiment taught in Merchant et al. A variety of the claimed copolymers, with water-solubility within the claimed range, are still taught by Merchant et al.

12. Again, regarding the argument the "Merchant does not provide the requisite disclosure to select monomers of water-soluble and LCST units and arrange them in the manner that would be the same as the polymer defined in the claimed method", applicant claims 44, which is representative of the claimed invention, only requires the presences of the water-soluble and LCST units in the polymer and any (co)polymer, such as the oxyalkylated amines and oxyalkylated polyols, each specifically named in Merchant et al. (see col. 5, lines 50-66), wherein the oxyalkylating groups are consistent with the defined LCST units and the amine and polyol group are water-soluble units.

13. Regarding Koerner et al., it is noted that the feature upon which applicant relies (i.e., "where the polymer does not exhibit an LCST [as] discussed on page 5, lines 16-31 of the present application") is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Regarding Foger et al., see previous response to arguments.

15. Regarding "the Maroy publications", see previous response to arguments. Again, the Maroy publications teach the same specific polymers containing LCST units described in applicant's specification is being consistent with the claimed polyoxyalkylene grafted polyacrylic acid polymers in the Maroy publications.

The water-soluble/LCST copolymers described in "the Maroy publications" are soluble at temperatures less than 100 °C, fully encompassing the claimed water-solubility range of 5 to 80°C. Appellant is reminded that the present claims are not to the LCST units themselves.

Finally, the polymers are not currently defined in the claims as "having a demixing temperatures of 5 to 40°C at 1% by mass in water". This limitation in recited in the claims with regard to the LCST units used in prepare the water-soluble polymers, not the polymer themselves.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE